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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/435,602	11/05/1999	MIKA LEPPINEN	4925-14	5428
7590	12/23/2002			
MICHAEL C STUART ESQ COHEN PONTANI LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			EXAMINER [REDACTED]	POLLACK, MELVIN H
		ART UNIT 2142	PAPER NUMBER 7	
DATE MAILED: 12/23/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/435,602	LEPPINEN, MIKA
	Examiner	Art Unit
	Melvin H Pollack	2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 October 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input checked="" type="checkbox"/> Other: <i>see attached office action</i> . |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed October 10, 2002, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The offending document, from Jens Michael, will not be considered until an English translation of the abstract, document, or brief description summary is sent to the office. All other documents in the IDS have been considered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection. As the scope of the claims has not changed, this action is non-final.

3. Applicant states that mobile device is not used to request content or resource. Examiner disagrees. This limitation is fulfilled when the mobile device makes the request, even if the content or resource is not received by the unit. Since it is clear that the mobile device is used to retrieve information from the internet, this limitation is fulfilled regardless of whether the content or resource is received by the unit.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "receiving of content and resources that are not user prompts, phone signals, commands or audio data") are not

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recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). “The receiving of content and resources” is sufficiently broad that it covers almost all forms of data, including all the ones above. Applicant should consider amending to a narrower list of information types in order to gain this limitation.

5. Applicant states that Mannings does not disclose that the gateway (CTI unit) is not redirected from one WWW server to another. Examiner states that there is a redirection from one server (Fig. 2, #2) to another (Fig. 2, #9). Examiner is forced to concede, however, that the first server makes the switch, rather than the gateway. Therefore, examiner is forced to withdraw this argument.

6. Applicant then states that Farber does not use a wireless network. It is considered in the art that the type of network is irrelevant for this type of purpose, and that the network connecting the client to the various components can be wire or wireless without any change in functionality.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “optimizing radio resources in a mobile network”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Applicant states that, in Farber, the redirection is handled at the client rather than the gateway. Examiner concedes this as well.

9. Applicant states that Mannings does not receive the content and resource from the gateway with the protocol they used to request the message. Examiner has shown above that

Mannings does indeed receive the content. Not only is it clear that the protocol is the same, but it would be hard to find an example where the client transmits with one protocol and the gateway transmits back with a completely different one.

10. Applicant states that Farber fails to teach two different protocols. Examiner does not contest this statement.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 1, 2, 5, 6, 8, and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by Cannon et al. (5,974,447).

13. For claim 1, Cannon teaches a method (see abstract) for minimizing data transmission (col. 3, lines 55-56) between a mobile station (Fig. 1, #18) and a gateway server (Fig. 1, #22), comprising the steps of:

- a. Transmitting by a mobile station to a gateway server a request for at least one of content and resource located on a web server (col. 2, lines 29-31) using a first protocol (Fig. 1, between #20 and #22);
- b. Transmitting the request by the gateway server to the web server (Fig. 1, #24) using a second protocol (Fig. 1, between #22 and #24) that is compatible with that used by the web server (col. 2, lines 22-26);

- c. Receiving a redirection message by the gateway server from the web server, the redirection message indicating a new location of the at least one of content and resource (col. 3, lines 9-11, where new location information is essential to perform the mapping, and is thus anticipated);
- d. Creating and transmitting by the gateway server to one of the web server and another web server another request for the at least one of content and resource at the new location in response to the redirection message (col. 3, lines 9-11);
- e. Receiving by the gateway server the at least one of content and resource from said one of the web server and another web server (col. 1, lines 39-40);
- f. Transmitting the at least one of content and resource from the gateway server to the mobile station using the first protocol (col. 2, lines 30-36).

14. As for claim 2, Cannon teaches that the new location of the at least one of content and resource is transmitted to the mobile station from the gateway server (col. 3, lines 1-11). In order for the user to select a priority order of where to look for the resource or content, the user must know where all the possible places to look are. Further, it would be trivial to set up a mechanism where the source map, or a message or header that includes some of the information, is transmitted from the gateway to the mobile device. Therefore, this limitation is also anticipated.

15. As for claim 5, Cannon teaches that the second protocol is based on a World-Wide Web (WWW) protocol (col. 5, lines 13-14).

16. As for claim 6, Cannon teaches that the second protocol is the Hypertext Transport Protocol (HTTP) (col. 5, line 10).

17. Claim 8 is a system implementation of claim 1. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claim 1 is rejected, then claim 8 is also rejected for the reasons above.

18. Claim 12 is a system implementation of claim 2. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claim 2 is rejected, then claim 12 is also rejected for the reasons above.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-3, 5, 6, 8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon as applied to claims 1, 2, 5, 6, 8, 12 above, and further in view of Daly et al. (6,393,014).

21. For claims 1, 2, that which is anticipated is obvious.

22. As for claim 3, Daly teaches that the new location is included as a header transmitted with the at least one of content and resource (col. 7, lines 20-40). Cannon also provides the new location information, as shown below, but does not disclose the precise mechanism to do so. At the time the invention was made, one of ordinary skill in the art would have included a Daly header in the Cannon messaging system so that Cannon invention gateways could more easily

map and track the servers and so that Cannon users could have up-to-date server information in order to prioritize which servers to check first.

23. Claim 11 is a system implementation of claim 3. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claim 3 is rejected, then claim 11 is also rejected for the reasons above.

24. Claims 1, 4, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon as applied to claim 1 above, and further in view of Martin, Jr. et al. (6,466,783).

25. For claim 1, that which is anticipated is obvious.

26. For claim 4, Cannon does not expressly disclose what the first protocol is. Rather, he states that it can be any of a myriad of undisclosed protocols (col. 4, lines 522-53). Martin teaches that the first protocol is based on the Wireless Application Protocol (WAP) (col. 5, lines 9-11). Further, it is well known in the art that WAP is a choice protocol designed specifically for sending internet-based content and resources to a mobile device. At the time the invention was made, one of ordinary skill in the art would have used Martin to set up the wireless connection in Cannon.

27. Claim 10 is a system implementation of claims 4-6. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claims 4-6 are rejected, then claim 10 is also rejected for the reasons above.

28. Claims 1, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon as applied to claim 1 above, and further in view of Dahm et al. (6,466,783).

29. For claim 1, that which is anticipated is obvious.
30. As for claim 7, Cannon does not expressly disclose how the request is coded, although he does disclose an encoder/decoder device (Fig. 2, #45). Dahm teaches that the request is coded as a Uniform Resource Locator (URL) (col. 10, lines 22-26). At the time the invention was made, one would have used Dahm to learn how to implement the Cannon encoder/decoder system.
31. Claim 9 is a system implementation of claim 7. The prior art teaches that a system implementation is functionally equivalent to the underlying method. Therefore, if claim 7 is rejected, then claim 9 is also rejected for the reasons above.
32. Claims 1-12 are also rejected under 35 U.S.C. 103(a) as being unpatentable over the WAP architecture specification and Jain (6,480,853) and Liao et al. (6,292,833).
33. The WAP architecture specification teaches that a wireless phone can request a content or resource from a server through a translating gateway (Fig. 2). The WAP specification teaches the use of WAP, HTTP, WWW and URLs to develop the protocols (Page 12).
34. The WAP specification does not expressly disclose multiple servers, even though multiple servers were well known in the art when the invention was made. As such, it does not expressly disclose going to another server when the first server fails to have the content. Jain teaches a model where a gateway (Fig. 2, #26) goes from web site to web site (Fig. 2, #20) in search of content information for the wireless mobile device (Fig. 24). And it does such by querying each web site to see if the information is present (Fig. 3). At the time the invention was made, one of ordinary skill in the art would have used Jain to flesh out the WAP specification so that the specification could include failure-response protocols and reflect the real world.

35. Neither expressly discloses the tracking and storage of the new location. Liao teaches this limitation (Fig. 3A, #308), and also teaches that is information is included in the header (col. 9, lines 1-3). At the time the invention was made, one of ordinary skill in the art would have used the Liao tracking system in order to provide information necessary to make a more efficient search.

36. A more detailed explanation or proof is similar to the proof of the first rejection.

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H Rinehart can be reached on (703) 308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

MHP
December 13, 2002



ROBERT B. HARRELL
PRIMARY EXAMINER